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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/711,339	09/06/96	BINGGELY	A 4019/135
EXAMINER			

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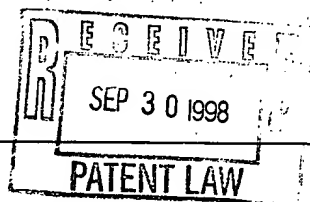
HM42/0925

ART UNIT	PAPER NUMBER
1613	

DATE MAILED: 09/25/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY



☒ Responsive to communication(s) filed on July 20, 1998

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 months month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
Of the above, claim(s) 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90, 92-95 is/are withdrawn from consideration.
☐ Claim(s) 49, 48-67, 73, 75, 76, 79-86, 41-136 is/are allowed.
☐ Claim(s) is/are rejected.
☒ Claim(s) 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90, 92-95 is/are objected to.
☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). (3 ms)
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

RESPONSE TO FINAL REJECTION &
NOTICE OF APPEAL DUE: December 25, 1998

STATUTORY PERIOD EXPIRES: March 20, 1999

COPY SENT TO
DEPARTMENT PLP

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Best Available Copy

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The subject matter of claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90 other than that wherein R1 is aryl optionally substituted by lower alkyl, lower alkenyl, trifluoromethyl, lower alkoxy, hydroxy - lower alkoxy, alkoxy alkoxy; R2 is phenyl or naphthyl each substituted by O-C1-8 alkylene -O-C1-8 alkylene-aryl wherein aryl is as defined for R1;

X is O, S;

Z is lower alkylene;

Q is absent;

m is O (W is absent);

R3 is hydrogen;

R4 is OH;

and the subject matter of claims 18, 19, 21-31, 34, 46, 48-67, 73, 75, 76, 79-86 and 91-136 stands withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to non elected inventions, election having been made in Paper No. 7, with traverse.

Applicant's traversal of the restriction requirement has been considered but is not found persuasive. Applicant has presented arguments which relate to improper Markush rejections and to MPEP 803.02. The issue here is one of restriction. 35 U.S.C. 121 gives the Commissioner the authority to restrict the examination of an application to one invention where two or more inventions are claimed. Thus the requirement to restrict the instantly claimed subject matter is predicated on the fact that the elected and examined subject matter ~~is~~ taken as a whole, and the non elected subject matter, taken as a whole, are so different in structure and element as to be

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patentably distinct one from the other, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non elected subject matter. Applicant has not argued otherwise or presented any evidence to show that the elected and non elected subject matter constitute the same invention, i.e. are obvious over each other.

Applicant also relies on the decisions of *In re Webber*, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 179 USPQ 623 (CCPA 1973). These two decisions involved the rejection of claims under 35 U.S.C. 121 and the withdrawal of an entire claim. This is not the situation here. The issue here is one of restriction, as has been stated *supra*. As such, the restriction as has been required, is proper.

Claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77 and 87-90 are objected to as containing non elected subject matter. The objection may be overcome by limiting the claims to the subject matter indicated as being examinable, *supra*. Claims so limited would appear allowable.

Claims 40, 78 and 137, presented in independent form or made dependent on an allowable claim, would appear allowable, otherwise they are objected to as being dependent on a non allowed claim.

Applicant should cancel the non elected subject matter or take other appropriate action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

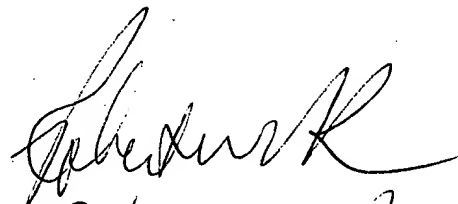
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. W. Ramsuer at telephone number (703) 308-4534.

R. Ramsuer:jmr

Sept. 23, 1998


Robert W. Ramsuer
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